

REMARKS

Claims 32-47 are pending in the present application. Claims 43, 44, 46, and 47 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,535,726 to Johnson. Claims 32-42 and 45 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of U.S. Patent No. 6,356,752 to Griffith. The claims have been objected to because of the numbering.

Objection to the Claims

On page 2 of the Office Action, the Examiner objects to the claims because:

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). Misnumbered claims 44 and 45 have been renumbered 46 and 47.

Accordingly, because misnumbered claims 44 and 45 (the second set) have been renumbered 46 and 47, the undersigned representative respectfully requests that the Examiner withdraw the objection to the claims.

Rejection of Claims 43, 44, 46, and 47 Under 35 U.S.C. § 102(e)

Claims 43, 44, 46, and 47 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,535,726 to Johnson. This rejection is respectfully traversed.

The Patent Office has a burden to prove anticipation of the claims. In order to maintain an anticipatory rejection under 35 U.S.C. § 102, a reference must teach every element of the claim. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.). The Patent Office has not met its burden of

proving that Johnson is an anticipatory reference with respect to claims 43, 44, 46, and 47.

Johnson does not disclose each and every element of claims 43, 44, 46, and 47. More specifically, Johnson does not disclose “debiting at least one account of the customer substantially in real-time in response to the debit message,” as recited in independent claim 43. To the contrary, Johnson recites debiting a customer’s cellular telephone bill rather than a substantially real-time debit of an account. “The supporting cellular network 160 processes the transaction charges against the customer account associated with the cellular telephone 140. The transaction charges would then appear on the customer’s cellular telephone bill.” Col. 6, lines 17-20 (emphasis added). Thus, Johnson recites charging a telephone bill, which would eventually be received by the customer. The customer would then pay the telephone bill, which would eventually be received by the telephone company, who would process the request to debit the customer’s telephone account. Such a lengthy process runs contrary to claim 43, which recites “a substantially real-time debit of an account.” When paying a bill using a wireless remote terminal, a “real-time debit of an account” cannot be disclosed by processing charges on a telephone bill. Charging a telephone bill does not anticipate a debit of an account.

Therefore, Johnson does not disclose each and every element of claim 43 as required by 35 U.S.C. §102(e). For at least these reasons, independent claim 43, as well as dependent claims 44, 46, and 47 are allowable over the cited art. Accordingly, it is respectfully requested that the rejection of claims 43, 44, 46, and 47 as being anticipated by Johnson be withdrawn.

Rejection of Claims 32-42 and 45 Under 35 U.S.C. § 103(a)

Claims 32-42 and 45 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of U.S. Patent No. 6,356,752 to Griffith. This rejection is respectfully traversed.

The combination of Johnson and Griffith does not establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria

must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Johnson and Griffith, neither alone nor in combination, teach or suggest all the claim limitations.

Neither Johnson nor Griffith teach or suggest each and every element of independent claim 32. More specifically, as similarly discussed above, Johnson does not teach or suggest “selectively effect debiting of the customer account substantially in real-time,” as recited in claim 32. As discussed above, Johnson recites billing to a customer's telephone account, rather than debiting from an account in real-time.

Griffith does not cure the deficiencies of Johnson. Griffith recites “specifying the type of account against which the transaction is to be billed.” Col. 2, lines 12-13 (emphasis added). Further, Griffith recites, “If a credit card number is being utilized, site computer 104 will contact a credit card database to verify that the number is valid.” Col. 3, lines 54-56. One recognizes that a credit card transaction is not the real-time debiting of a customer's account. In a credit card transaction, the customer receives a bill each month. The customer pays the bill and the credit card company processes the payment to debit the customer's account. In contrast, the present application recites “debiting ... substantially in real-time.” The “real-time” debiting is not taught or suggested by the payment systems in Johnson and Griffith, which are likely to occur weeks later.

Therefore, neither Johnson nor Griffith, singularly or in combination, teach or suggest each and every element of claim 32 as required by 35 U.S.C. §103(a). For at least these reasons, independent claim 32, as well as dependent claims 33-42, are allowable over the cited art. Additionally, since independent claim 43 is patentable

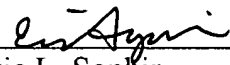
over Johnson for the reasons stated above and since Griffith does not cure the deficiencies of Johnson, claim 45 is patentable over the cited art for the same reasons stated above. Accordingly, it is respectfully requested that the rejection of claims 32-42 and 45 under 35 U.S.C. §103(a) be withdrawn.

CONCLUSION

The undersigned representative respectfully submits that this application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that the prosecution might be advanced by discussing the application with the undersigned representative, in person or over the telephone, we welcome the opportunity to do so. In addition, if any additional fees are required in connection with the filing of this response, the Commissioner is hereby authorized to charge the same to Deposit Account No. 501458.

Respectfully submitted,

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